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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
MICHALSKI, SEAN M	

ART UNIT	PAPER NUMBER
3724	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/970,015	VEGLIANTE ET AL.	
	Examiner	Art Unit	
	SEAN M. MICHALSKI	3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 July 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,5,11-14,16-23,38-40 and 42-44* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,5,11-14,16-23,38-40 and 42-44* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/25/2008 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. The level of ordinary skill in the art is considered to be a person with a B.S. degree in Mechanical engineering, a closely related field or equivalent work experience, as indicated by the quality, nature and extent of the cited references, and additionally, the person of ordinary skill in the art would have some experience with the design and selection of polymer elements, since rails as seen in the prior art of rail style cutters are typically formed of polymers generally.

4. Claims 1, 5, 11-14, 17, 20-23, 40,42,43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lucas in view of Wankow (3,549,066; hereinafter Wankow) with supporting evidence from Boda (5,524,515), Urion (4,210,043) Tsai (5,036,740) as set forth in a previous action (Dated 7/03/2007).

5. Claims 1, 5, 11-14, 20-23, 38-40, 42-44 rejected under 35 U.S.C. 103(a) as being unpatentable over Chuang (US 4,960,022 and an artifact submitted by a third party on 8/25/2008 in copending case 09/741,521, entered into the record thereof as "09741521MA") in view of Lucas (US 5,440,961) in view of Wankow (US 3,549,066), "Phthalate Ester Plasticizers-Why and How They Are Used", and Gearhart (US 4,856,975) .

In this action, there is an artifact designated to correspond with US 4,960,022; however if any differences are detected between the artifact and the subject of the patent, it is to be understood that both the Patent number US 4,960,022 and the Artifact are being applied whenever "Chuang" is cited. That is to say "Chuang" is to encompass both pieces of prior art including the patent US 4,960,022 and the artifact submitted 8/25/2008 and labeled as "09741521MA" in the record.Chuang teaches a film cutter apparatus (figure 3B) comprising an elongated rail base with a pair of elongated rails formed at the top thereof (see figure 3A) and a channel formed within said rail base and between said sails (seen in figure 3A). Chuang further discloses a blade housing including an upper portion (308A and 323 in figure 3C respectively). Chuang further discloses the upper housing houses (329 figure 3C) a blade (319 and 320) the bottom edge of the upper portion protrudes on either side of the blade (as seen in figure 3C).

Chuang discloses that the blade is angled from the bottom edge of the upper portion (319, 320; as seen in figure 3C and figure 3D). Chuang discloses that the upper portion of the housing has a grip surface being a concave shape, as seen in figure 3C. Chueng discloses that the rail base includes a depression (elements 302-306 as seen in figure 3A define 'depressions') capable of receiving a cover of a carton of film.

Chuang does not disclose that the end surface of the upper housing is 'curved', but that it is angled (see figure 3C).

It would have been obvious to one of ordinary skill in the art at the time of the invention to make the angle as seen on the bottom surface of the upper housing in figure 3C rounded upwardly instead of angled upwardly. This is an obvious design choice that one of ordinary skill in the art could make with no undue experimentation. A designer would simply select 'curved' over 'angled' and the function would be the same, it would just have a slightly different appearance. A designer could have decided to create a curve for it's aesthetic appearance with no change to the function of the tool.

Chuang discloses that the lower portion of the blade housing is moveable in the channel (figures 3A-3C).

Examiner has a model of Chuang, imprinted with the patent number, which was submitted by a third party in case number 09/741,521 on 08/25/2008. The rails of this model appear to be rigid vinyl, or rigid plastic of some kind. The entirety of the apparatus is made from one material. The "rails are formed of a first material which provides an attraction to plastic wrap received over said rails", capable of "attracting said plastic wrap received over said rails for clinging said plastic wrap to said rails

before, during and after cutting of said plastic wrap by sliding said blade housing within said channel". Examiner has witnessed this first hand, by pulling plastic wrap across the rails, and pressing down on the blade housing moving the blade housing across the plastic to cut it.

Though the disclosure of Chuang is silent as to the particular material chosen (for the “second material”-that of the base), the model uses what is clearly rigid plastic, rigid vinyl or rigid PVC of some kind.

Examiner takes official notice that a person of ordinary skill in the art would have known about the materials vinyl and PVC and their properties such as strength and elasticity and cost.

Vinyl and PVC are both known materials, the selection of a specific material for a base rail would be within the level of ordinary skill in the art, since it has been held to be within the general skill of a worker in the art to select a known component or material on the basis of suitability for the intended use as a matter of obvious mechanical design expediency. *In re Leshin,* 125 USPQ 416. Also see MPEP 2144.07. *Sinclair & Carroll Co. v. Interchemical Corp.* states "Reading a list and selecting a known compound to meet known requirements is no more ingenious than selecting the last piece to put in the last opening in a jig-saw puzzle." 325 U.S. at 335, 65 USPQ at 301.). Since the base material is of a standard design and use, the designation of a specific material does nothing to enhance the patentability of a design.

Lucas discloses using a second material applied to the top surface of a rail style cutter in order to increase the friction thereon, and therefore increase the

attachment/cling/adhesion/attraction of a film to the top surface of the rails of the cutter. See the figures which show an adhesive/attractive/high friction material on both top rails of the rail style cutter (figure 1). See also a description of the intent of the added friction/adhesion at column 3 lines 1-17. Lucas discloses “urethane tape" or “other coatings or tapes” maybe used.

It would have been obvious to one of ordinary skill in the art to add a “first” material layer to the top rails of Chuang to enhance the cling/attraction/adhesion properties of the rails, as taught by Lucas.

Neither Chuang nor Lucas discloses “polyvinyl chloride comprising at least 10% plasticizer”.

Lucas discloses “urethane tape" or “other coatings or tapes” maybe used. The suggestion contained within this comment is that any material known to a person of ordinary skill that would enhance the “cling” of plastic wrap to the top rails of a rail style cutter can be added thereto in order to enhance the cutting of the cutter, by providing for a more securely attached and held plastic wrap.

Chuang is also concerned with providing a secure adhesion/attraction between the film and the rail, as seen by the wheels which press down enhancing the static cling experienced by the plastic wrap.

Wankow discloses a plasticized vinyl chloride (Table I, the fifth 'spot material' lists “plasticized vinyl film"). Also in column 3, the term "vinyl" in the specification is defined to mean "vinyl chloride and copolymers...". It should also be noted that in the art vinyl chloride *means* polyvinyl chloride, since monovinyl chloride is not a final product—

substantially always an intermediate since monovinyl chloride is toxic and hazardous to human health. Wankow discloses that the materials can be "print[ed]..paint[ed]...on the carton". The material is for adhesion/attraction/cling of plastic wrap to a spot.

It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize a polyvinyl chloride with plasticizer material as the "coating or tape" specifically motivated, suggested and requested by Lucas for the purpose of adhering/causing to cling/ attracting plastic wrap to a rail, since Wankow discloses that a polyvinyl chloride with plasticizer will work to attract/adhere/cause to cling plastic wrap thereunto.

Lucas in view of Wankow does not disclose that the plasticizer exceeds 10%. Polyvinyl chloride having plasticizer exceeding 10% is a **known material** by persons of ordinary skill in the art. See the footnote "a" of "**Phthalate Ester Plasticizers-Why and How They Are Used**" page 8, which explicitly discloses the known use of 40% plasticizer in PVC (polyvinyl chloride) at least as early as January 1973.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use plasticizer exceeding 10%, since it has been held that discovering an optimum result of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980), **and/or in addition or alternatively** since it has been held to be within the general skill of a worker in the art to select a known component or material on the basis of suitability for the intended use as a matter of obvious mechanical design expediency. *In re Leshin*, 125 USPQ 416. Also see MPEP 2144.07. *Sinclair & Carroll Co. v. Interchemical Corp.* states "Reading a

list and selecting a known compound to meet known requirements is no more ingenious than selecting the last piece to put in the last opening in a jig-saw puzzle." 325 U.S. at 335, 65 USPQ at 301.).

Lucas does not disclose that the adhesive or frictional material is “co-extruded” with the base rail, but that the material is “adhered” thereto.

Wankow discloses that the polyvinyl chloride may be “print[ed]..paint[ed]...on the carton, but does not disclose "co-extrusion" as a means to apply one PVC compound onto another.

Gearhart discloses “coextrusion” for the forming together into one piece two different PVC layers, by extruding each layer from a different hopper into the same die, as seen in the figures. Column 1 lines 14-18 describes that coextruding two kinds of PVC allows two different materials (with somewhat different properties) to be utilized at two different zones.

It would have been obvious for a person having ordinary skill in the art to coextrude the first material with the second material, as disclosed by Gearhart, since it is a known method for adhering two different PVC materials together to form a singular whole.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use an angle of 30 degrees, since it has been held that discovering an optimum result of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claim 13, the lower portion of Chuang is clearly a tracking device capable of slidably moving in the channel.

Regarding claim 14, the channel and tracking device of Chuang are not "tubular" which typically at least means "generally cylindrical". Chuang discloses a T-shaped tracking device with a middle portion attaching the T portion (lower portion/tracking device) to the upper portion. Chuang does disclose that the middle portion is of a predetermined length, since it is designed to fit within the channel as that is designed (see figure 3C of Chuang). The main feature of the tracking portion and channel is that they are *corresponding* shapes.

Examiner takes official notice that a person of ordinary skill in the art knows about a number of different shapes, such as tubular/tubes/cylinders and rectangular prisms.

A person of ordinary skill in the art would have made the tracking device and channel any corresponding shape, such as tubular, elongated trapezoid, rectangular prism or any other common shape known generally to persons of ordinary skill in the art, since the design need is only that the channel and tracking device correspond to one another, and one shape works just as well as any other.

6. Claims 1 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chuang (US 4,960,022) in view of Lucas (US 5,440,961) in view of Wankow (US 3,549,066), "Phthalate Ester Plasticizers-Why and How They Are Used", and Gearhart (US 4,856,975) as set forth above and further in view of Urion (4,210,043).

Chuang (US 4,960,022) in view of Lucas (US 5,440,961) in view of Wankow (US 3,549,066), "Phthalate Ester Plasticizers-Why and How They Are Used", and Gearhart (US 4,856,975) does not use acetal as the material for the blade housing.

Urion discloses using acetal as the material for a sliding rail style cutting blade holder/housing (see column 7 lines 35-40), since it is economical.

7. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chuang (US 4,960,022) in view of Lucas (US 5,440,961) in view of Wankow (US 3,549,066), "Phthalate Ester Plasticizers-Why and How They Are Used", and Gearhart (US 4,856,975) as applied to claims 1, 5, 11-14, 20-23, 38-40, 42-44 above, and further in view of Chiu (US 5,398,576).

Chuang uses slot configurations as at 302-306 figure 3A to secure the rail cutter to a box.

Chiu discloses that the rail assembly is "mounted securely" to a box (Column 2, lines 54 and 55), and in the figures shows no slots, rivets, screws, magnets or other attachment means, but does show a flat bottom surface on the base of the rail assembly (see figures).

Examiner takes official notice that a person of ordinary skill in the art would have knowledge of "glue" or "adhesive" for use in attaching things together. That is glue/adhesive is a well known material for attaching things together in permanent or semi-permanent state.

It would have been obvious to a person having ordinary skill in the art to use a glue attachment for the rail style cutter of Chuang in view of Wankow (US 3,549,066), "Phthalate Ester Plasticizers-Why and How They Are Used", and Gearhart (US 4,856,975) as taught by the disclosure of Chiu in light of ordinary skill or common knowledge, since attaching rail style cutters with adhesive is the functional equivalent of using a slot configuration.

8. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chuang (US 4,960,022) in view of Lucas (US 5,440,961), Wankow (US 3,549,066), "Phthalate Ester Plasticizers-Why and How They Are Used", and Gearhart (US 4,856,975) as set forth above, and further in view of Keene (US 3,277,760).

Chuang (US 4,960,022) does not disclose a protrusion in the channel, the lower portion of the blade housing "snap-fits" "into" said protrusion.

Keene discloses a protrusion (46 figure 2) that the lower housing member (44) snaps "into" (as 40, seen figure 2). Alternatively there could be considered a protrusion 40 on the lower portion of the housing, and a receptacle inside the rail channel (at 46 figure 2). This is a question of terminology.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to add one retention element to the lower portion of a blade housing in a rail style cutter, and a corresponding retention element to the side of the channel of the rail style cutter as taught by Keene, for the purpose of retaining a slide cutter at one end of

a channel in a rail style cutter. The selection of which gets the "protrusion" and which the "receptacle" is irrelevant, since each of the channel/rail and the lower cutter housing will get a different one, and the reversal of parts is within the level of ordinary skill besides. It has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167.

Response to Arguments

9. Applicant's arguments filed 7/25/2008 have been fully considered but they are not persuasive.

The arguments related to the rejections of record are not persuasive, since they fail to adequately treat the rejections of record, instead attacking the references individually.

Response to Declaration

10. The declaration under 37 CFR 1.132 filed 7/25/2008 is insufficient to overcome the rejection of claims 1, 5, 11-14, 16-24, 38-40 and 42-44 based upon their prima facie obviousness as set forth in the last Office action because:

a. The declaration appears to be trying to establish a showing of commercial success, but fails to establish the **necessary nexus** between the claimed features and the increase in sales/demand. The declaration also fails to quantify, in an appreciable manner and "in a clear and convincing" manner what the change in sales/distribution/demand for products with the specific features of the claim. Specifically, the numbers presented are all estimates, and cite no

methodology nor documentary evidence to support the conclusions of "30-50 million" of the slide cutter products. The statement that "AEP moves...3 million pieces" does not establish why those pieces are being moved relative to the "market" in 1998/1999 was 100,000 per year of Conventional cutters. This comparison is additionally flawed, since the "100,000" number comes from AEP alone,(See exhibits A-F; no other conventional cutter numbers from the total market being sought or provided). There is no base 'market' established in the evidence. The affiant states that "Reynolds film…represents about 12 million boxes annually" (with the claimed features of "cling") however since there is no showing of what the Reynolds numbers were prior to the alleged stealing, there can be no showing that the numbers are any different than what would have occurred without the alleged infringement.

b. There appears to be a declaration seeking to show that there has been copying by another (infringement). However, there is no comparison of the pending claim to the accused infringer, nor any *evidence* of duplication. The only comparison is "a very novel cling of plastic wrap"; no conclusion may be drawn as to the pending claims.

c. In element 11 of the declaration, Affiant asserts that the product (as in claim 1) "and duplicates" have penetrated as much as 25 % of the retail sales market. There is no factual evidence to support this assertion in the record. Nor is there any information on how this number was generated. The total number of alleged duplicates (from element 15 of the declaration) is between 30 and 50

million. if this is only 25 % of the market, where is there evidence of 90-150 million total cutting devices of a non-infringing nature. The numbers of estimates are just that-estimates, with no supporting evidence. The allegation that the market has expanded from 100,000 total rail style cutters (flawed due to only citing AEP cutters) to 30 million (flawed at least due to estimation) does not give the kind of probative evidence that is useful in determining the obviousness of the claims at bar.

d. Regarding element 13 of the declaration, the number of countries where alleged "duplicates" of the product defined by the claims at issue are used, is interesting, but there is no evidence to support the conclusion that the accused devices are copied from applicant, or that they infringe on applicant.

Applicant is reminded; from MPEP 716.03 : *Commercial Success >I. < NEXUS BETWEEN CLAIMED INVENTION AND EVIDENCE OF COMMERCIAL SUCCESS REQUIRED An applicant who is asserting commercial success to support its contention of nonobviousness* ***bears the burden of proof*** *of establishing a nexus between the claimed invention and evidence of commercial success. The Federal Circuit has acknowledged that applicant bears the burden of establishing nexus, stating: In the ex parte process of examining a patent application, however, the PTO lacks the means or resources to gather evidence which supports or refutes the applicant's assertion that the sale constitute commercial success. C.f. Ex parte Remark, 15 USPQ2d 1498, 1503 (Bd. Pat. App. & Int. 1990)(evidentiary routine of shifting burdens in civil proceedings*

inappropriate in ex parte prosecution proceedings because examiner has no available means for adducing evidence). Consequently, the PTO must rely upon the applicant to provide ***hard evidence*** *of commercial success. In re Huang , 100 F.3d 135, 139-40, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996). See also In re GPAC, 57 F.3d 1573, 1580, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995); In re Paulsen, 30 F.3d 1475, 1482, 31 USPQ2d 1671, 1676 (Fed. Cir. 1994) (Evidence of commercial success of articles not covered by the claims subject to the 35 U.S.C. 103 rejection was not probative of nonobviousness). The term "nexus" designates a factually and legally sufficient connection between the evidence of commercial success and the claimed invention so that the evidence is of probative value in the determination of nonobviousness. Demaco Corp. v. F. Von Langsdorff Licensing Ltd., 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir. 1988).*

Also from 713 .06(b):

"an applicant must show that the claimed features were responsible for the commercial success of an article if the evidence of nonobviousness is to be accorded substantial weight. See In re Huang,100 F.3d 135, 140, 40 USPQ2d 1685, 1690 (Fed. Cir. 1996) (Inventor's opinion as to the purchaser's reason for buying the product is insufficient to demonstrate a nexus between the sales and the claimed invention.). Merely showing that there was commercial success of an article which embodied the invention is not sufficient.

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness."

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SEAN M. MICHALSKI whose telephone number is (571)272-6752. The examiner can normally be reached on M-F 7:30AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sean M Michalski/
Examiner, Art Unit 3724

/Kenneth Peterson/
Primary Examiner, Art Unit 3724